UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/674,593	06/07/2001	Benoit Van Den Eynde	L0461/7099	9143

7590 06/18/2002

Wolf Greenfield & Sacks
Federal Reserve Plaza
600 Atlantic Avenue
Boston, MA 02210-2211

EXAMINER
HUNT, JENNIFER ELIZABETH

ART UNIT	PAPER NUMBER
1642	11

DATE MAILED: 06/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/674,593	Applicant(s) EYNDE ET AL.	
	Examiner Jennifer E Hunt	Art Unit 1642	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-65 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 1-65 are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-14, 25-28, 29 in part, 30-31, 34 in part, 47, 48, 54 in part, 55 in part, 56-58, 60 in part, 61-62, and 65 in part, drawn to a RUR-1 polynucleotide, corresponding vector, host cell, kit, and method of using such to diagnose a disorder.

Group II, claim(s) 15-20, 49-51, 54 in part, 55 in part, and 59, drawn to a polypeptide.

Group III, claim(s) 21-24, drawn to a binding protein.

Group IV, claim(s) 29 in part, 32, 34 in part, 60 in part, 63, and 65 in part drawn to a method of using a cell to diagnose a disorder.

Group V, claim(s) 29 in part, 33, 34 in part, 60 in part, 64, and 65 in part, drawn to a method of using an antibody to diagnose a disorder.

Group VI, claim(s) 35-37, and 41-43, drawn to a method of treating a subject by administering a polypeptide.

Group VII, claim(s) 38-40, drawn to a method of treating a subject by administering a cell.

Group VIII, claim(s) 44-46, drawn to a method of enriching a population of T cells.

Group IX, claim(s) 52-53, 54 in part, and 55 in part, drawn to a cell.

The inventions listed as Groups I-IX do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

An international and a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

(1) A product and a process specially adapted for the manufacture of said product; or

(2) A product and a process of use of said product; or
(3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
(4) A process and an apparatus or means specifically designed for carrying out the said process; or
(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

Group I encompasses a product and a process of using that product. The products and methods of Groups II-IX encompass distinct products and methods of use.

The products of Groups I-III and XI are completely different products, having different structures and physiological functions. The nucleic acid of Group I has a distinct structure and function from the polypeptide of Group II. The binding protein of Group II has a distinct structure and function from both the nucleic acid and polypeptides of Groups I-II, and the cell of Group IX has a distinct structure and function from the polypeptide of Group I, or the polynucleotide of Group II, or the binding protein of Group III.

The methods of Groups I and IV-VIII are distinct from the aforementioned products, and further are distinct from each other. The method of Group I uses a polynucleotide to determine a diagnosis, while the method of Group IV uses a cell to determine a diagnosis, while the method of Group V uses an antibody to diagnose a disorder, while the method of Group VI uses a polypeptide to treat a subject, while the method of Group VII uses a cell to treat a subject, while the method of Group VIII

uses cells to enrich T cells. These are different methods, having different starting points, different methods, and different objectives or ultimate outcomes.

This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

If any of Groups I-V are elected, applicant must further elect -

A1 - A sense polynucleotide, polypeptide, and corresponding methods, or

A2 - An antisense polynucleotide, polypeptide, and corresponding methods

If any of Groups I-II are elected, applicant must further elect -

B1 - One RUR polynucleotide or corresponding polypeptide, or

B2 - An RUR-1 polynucleotide or corresponding polypeptide and another non RUR-1 polypeptide or polynucleotide.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or

otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons:

Groups A1-A2 are drawn to distinct molecules which have different structures, physiological functions and indicate different physiological conditions

Groups B1-B2 contain distinct products. Single molecules, and molecule complexes have different structures, and induce different physiological effects.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E Hunt whose telephone number is (703) 308-7548. The examiner can normally be reached on Monday-Friday, 6-3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa can be reached on (703) 308-3995. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3014 for regular communications and (703) 308-4242 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0196.

ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600

Jennifer E Hunt
Examiner
Art Unit 1642

jeh
June 4, 2002